

REMARKS

I. Introduction

The undersigned thanks Examiner Swiger for his review and consideration of the present Application. In response to the Final Office Action mailed August 21, 2008, the undersigned submits the following amendment and remarks. Upon entry of the amendment, claims 1, 3-5, 8-10, 12 and 25-36 are pending in the application. The present amendment amends claims 1, 3, 9, 10, 12, and 25-36, cancels claims 2, 6-7, and 11, and adds claims 37-40. Support for these amendments and additions can be found in Figures 4-9 and at paragraphs 43 and 47-48. Claims 13-24 remain cancelled. No new matter has been added by the present amendment.

The present amendment and response is believed to overcome all of the prior Office Action rejections, and allowance of the pending claims is kindly requested.

II. Rejection of Claims 1-9, 25, 27, 29, 32 and 35

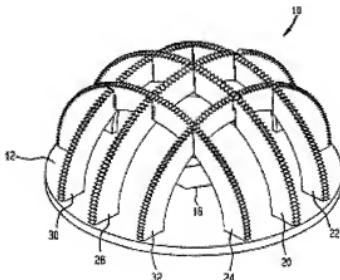
The Office Action rejects claims 1-9, 25, 27, 29, 32 and 35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,775,719 to *Frieze et al.* ("Frieze"). Claims 2 and 6-7 are cancelled by the present Amendment and Response and thus the rejection of these claims is moot.

A. *Frieze*

Frieze discloses an acetabular reamer having a first set of semi-circular cutter blades and a second set of semi-circular cutter blades that cross and intersect with the first set of cutter blades at right angles. As shown in Figure 2 of the patent reproduced below, the arrangement of the first set of cutter blades (20, 22, and 24) and the second set of cutter

blades (28, 30, and 32) of the reamer of *Frieze* results in a plurality of open spaces between the cutter blades.

FIG. 1



Among other things, the reamer disclosed in *Frieze* is not well suited for minimally invasive surgery due to the distribution of cutting teeth generally across the entire exterior of the structure.

B. *Frieze Does Not Anticipate Pending Claims 1, 3-5, 8-10, 12, and 25-40.*

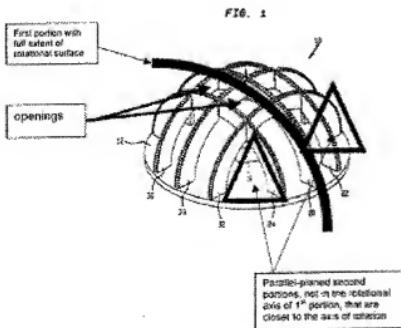
For a reference to anticipate a claim under § 102, it must describe, either expressly or inherently, each and every element set forth in the claim. MPEP § 2131. *Frieze* does not disclose, either expressly or inherently, each and every element set forth in the pending claims.

Amended independent claims 1, 25, 27, and 35 define a reamer comprising an exterior surface including a first portion and at least one second portion, the first portion dimensioned substantially as a surface of rotation about a rotational axis and comprising a plurality of raised edges for cutting the bone or the cartilage and a plurality of openings, and

the at least one second portion forming at least one generally planar exterior surface that is free of any raised edges for cutting the bone or the cartilage. Moreover, the first portion of the exterior surface includes a peripheral edge that forms at least a portion of a first arc, wherein an intersection of the first portion and the at least one second portion forms a second arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion.

Among other things, *Frieze* does not disclose expressly or inherently a reamer having a first portion and at least one second portion, where (1) the at least one second portion forms at least one generally planar exterior surface, and (2) the first portion has a peripheral edge that forms at least a portion of a first arc, and where an intersection of the first portion and the at least one second portion forms a second arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion.

As shown in the figure reproduced below, which was annotated by the Examiner, it is the Examiner's position that the open spaces highlighted as triangular shapes can be second portions. Currently amended claims 1, 25, 27, and 35 require that the at least one second portion form a generally planar exterior surface. The highlighted areas below are open spaces and thus are not exterior surfaces at all, let alone generally planar exterior surfaces. Thus, *Frieze* does not disclose "at least one second portion" as defined by claims 1, 25, 27, and 35.



Moreover, *Frieze* does not disclose a first portion and at least one second portion where an intersection of the first portion and the at least one second portion forms an arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion. Specifically, there is no intersection of the first portion and the second portion as identified by the Examiner in the reamer of *Frieze* that forms an arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion. Accordingly, for at least these reasons, *Frieze* does not anticipate independent claims 1, 25, 27, and 35.

Pending claims 3-5 and 8 depend from claim 1. Claim 26 depends from claim 25 and claim 28 depends from claim 27. Thus, dependent claims 3-5, 8, 26, and 28 are patentable for the reasons independent claims 1, 25, and 27 are patentable, and may be patentable for additional reasons.

Amended independent claims 9, 29, 32, and 36 define a reamer having an exterior surface that includes a first portion and at least one second portion, where the first portion

comprises a plurality of raised edges and a plurality of openings and where the raised edges are confined to an area of the first portion in a band straddling a middle portion of the reamer, and where the at least one second portion forms a portion of the exterior surface and has no raised edges or openings.

Frieze does not disclose a reamer having a first portion and at least one second portion, where the at least one second portion forms a portion of the exterior surface and where the raised edges are confined to the first portion in a band straddling a middle portion of the reamer. Instead, *Frieze* discloses a reamer having raised edges that are distributed throughout the entire surface of the reamer, and are not confined to a band straddling the middle portion. Moreover, *Frieze* does not disclose a second portion that forms a portion of the exterior surface. As shown above, the open spaces identified by the Examiner as a second portion do not form a portion of the exterior surface. Thus, *Frieze* does not anticipate independent claims 9, 29, 32, and 36.

Claims 10 and 12 depend from claim 9. Claims 30 and 31 depend from claim 29 and claims 33 and 34 depend from claim 32. Thus, dependent claims 10, 12, 30-31, and 33-34 are patentable for the reasons independent claims 9, 29, and 32 are patentable, and may be patentable for additional reasons.

New independent claims 37 and 39 define a reamer having a cup-shaped hollow body, the hollow body having an exterior surface and an open end and a substantially closed end that define an interior volume spatially bounded by (1) a first portion of the exterior surface having a plurality of raised edges and (2) at least one second portion of the exterior surface configured to maintain the fragments of bone or cartilage within the interior volume. New

claim 37 requires that the first portion of the exterior surface include a peripheral edge that forms at least a portion of a first arc, wherein an intersection of the first portion and the at least one second portion forms a second arc that extends from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion. New claim 39 requires that the raised edges are confined to an area of the first portion in a band straddling a middle portion of the exterior surface of the cup-shaped hollow body.

As shown above, *Frieze* does not have a second portion that is configured to maintain bone fragments within an interior volume of the reamer. Instead, *Frieze* has open spaces distributed throughout the reamer that are not surfaces at all, let alone capable of maintaining bone fragments within an interior volume of the reamer. Thus, *Frieze* does not anticipate new independent claims 37 and 39. Moreover, as shown in detail above, *Frieze* does not disclose a first portion and at least one second portion where an intersection of the first portion and the at least one second portion forms an arc that extends from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion, and thus does not anticipate claim 37 for this additional reason. In addition, as explained above, *Frieze* discloses a reamer having raised edges that are distributed throughout the entire surface of the reamer, and are not confined to a band straddling the middle portion, and thus does not anticipate claim 39 for this additional reason.

Claim 38 depends from claim 37 and claim 40 depends from claim 39. Thus, dependent claims 38 and 40 are patentable for the reasons independent claims 37 and 39 are patentable, and may be patentable for additional reasons.

Accordingly, the undersigned submits that claims 1, 3-5, 8-10, 12, and 25-40 are not anticipated by *Frieze* and are in a condition for allowance.

III. 35 U.S.C. § 103 Rejections

A. *Rejection of Claims 10, 12, 31 and 34*

The Office Action rejects claims 10, 12, 31 and 34 under 35 U.S.C. § 103(a) as unpatentable over *Frieze* in view of U.S. Publication No. 2006/0129157 to *Desarzens, et al.* (“*Desarzens*”). The undersigned respectfully traverses the rejection of claims 10, 12, 31 and 34 and requests withdrawal thereof. (Claim 11 is cancelled by the present Amendment and Response and thus the rejection of this claim is moot.)

Independent claims 9, 29, and 32, upon which claims pending claims 10, 12, 31 and 34 respectively depend, have been amended to define a reamer having an exterior surface that includes a first portion and at least one second portion, where: (1) the first portion comprises a plurality of raised edges and a plurality of openings; (2) the raised edges are confined to an area of the first portion in a band straddling a middle portion of the reamer; and (3) the at least one second portion forms a portion of the exterior surface and has no raised edges or openings.

The Office Action fails to make and articulate findings of fact that support an obviousness rejection of these claims under 35 U.S.C. § 103. To establish *prima facie* obviousness of claims 10, 12, 31 and 34 under 35 U.S.C. § 103, the Office Action must (1) rely on references that expressly or inherently show each claimed element, and (2) show, either from the references themselves or in the knowledge generally available to one of

ordinary skill in the art, that it would have been obvious under *Graham v. John Deere Co.*¹ to modify the references or to combine teachings in the references to arrive at the claimed invention.² Such a showing requires, among other things, evidence of an apparent reason to combine these elements in those references.³ The undersigned submits that: (a) even assuming the cited references could be combined, the combination of cited references fails to disclose or suggest each claimed element; (b) the purported combination of references is inapposite; and (c) the Office Action fails to articulate the required findings to establish *prima facie* obviousness.

1. *The Cited References Fail to Disclose or Suggest Each Claimed Element*

As discussed above, to establish *prima facie* obviousness of a claimed invention under 35 U.S.C. § 103, the Office Action must show, among other things, that the cited references disclose or inherently suggest each claimed element.⁴ *Frieze* and *Desarzens*, even if they could or should be combined, whether alone or in combination, fail to disclose or suggest each element of the amended claims. For at least that reason, the undersigned respectfully requests withdrawal of the rejection of pending claims 10, 12, 31 and 34.

As established in Section II.B. above, *Frieze* fails to disclose at least:

(a) A reamer having a first portion and at least one second portion, where the at least one second portion forms a portion of the exterior surface and where the

¹ 383 U.S. 1 (1966).

² See MPEP §§ 706.02(j), 2141 and 2143; *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d at 1395-96.

³ See *KSR Int'l Co. v. Teleflex, Inc.* 82 U.S.P.Q.2d at 1596 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")).

⁴ See MPEP §§ 706.02(j), 2141 and 2143; *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d at 1395-96.

raised edges are confined to the first portion in a band straddling a middle portion of the reamer. Instead, *Frieze* discloses a reamer having raised edges that are distributed throughout the entire surface of the reamer, and are not confined to a band straddling the middle portion.

(b) A second portion that forms a portion of the exterior surface. As shown above, the open spaces identified by the Office Action as a second portion do not form a portion of the exterior surface.

Desarzens fails to disclose a second portion that forms a portion of the exterior surface of the reamer. Instead, the reamer has no sides.

Accordingly, neither *Frieze* or *Desarzens* discloses the claimed second portion that forms a portion of the exterior surface of the reamer. Such an omission constitutes an independent grounds for reconsideration and withdrawal of the obviousness rejection.

2. *The Combination of References is Inapposite*

Even if the references disclosed every claimed element, which they fail to do, and even if the Office Action cited any evidence to support a reason to combine these references, which it fails to do, such an effort to combine these references in the way suggested by the Office Action to arrive at the claimed invention is inapposite because it would render a result that (a) is insufficient to arrive at the claimed structures; and (b) teaches away from the claimed structures rather than leading to them.

Even if a person of ordinary skill in the art tried to combine *Frieze* and *Desarzens*, which Applicants do not concede makes any sense, the combination would result in, most likely either (1) a reamer having the crossing cutting blades of *Frieze* in the middle of the

reamer and with no sides, as dictated by *Desarzens*, or (2) a reamer having the cutting teeth of *Desarzens* in a band on the reamer with the crossing cutting blades of *Frieze* on the rest of the reamer. The first alternative combination does not produce a reamer that has a generally dome shaped exterior surface, or a second portion that forms a portion of the exterior surface, as required in these claims. The second alternative combination does not produce a reamer that has raised edges that are confined to the first portion in a band straddling the middle portion of the reamer and having a second portion that is free of any raised edges or openings, as required in these claims.

Additionally, for similar reasons, combination of *Frieze* and *Desarzens* teaches away from the claimed structures. *Frieze*'s cutting teeth are distributed generally around the entire exterior of the reamer, while *Desarzens*'s shape is a section of a dome that has no sides. Rather than producing a reamer with a generally dome shaped exterior surface that includes a band of raised edges, as claimed in claims 10, 12, 31 and 34, combining *Desarzens* with *Frieze* would result in, most likely, either (1) a reamer having the crossing cutting blades of *Frieze* in the middle of the reamer and with no sides, as dictated by *Desarzens*, or (2) a reamer having the cutting teeth of *Desarzens* in the middle of the reamer with the crossing cutting blades of *Frieze* making up the rest of the reamer. The first alternative combination teaches away from a reamer that has a second portion that forms a portion of the exterior surface, and the second alternative combination teaches away from a reamer having raised edges that are confined to the first portion in a band straddling the middle portion of the reamer and having a second portion that is free of any raised edges or openings.

The undersigned accordingly respectfully requests that the obviousness rejection of pending claims 10, 12, 31, and 34 be withdrawn for this independent reason.

3. Failure to Articulate the Required Factual Findings for *Prima Facie* Obviousness

MPEP § 2142 provides that the “key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”⁵ *See also*, 35 U.S.C. § 132; *KSR Int'l Co. v. Teleflex, Inc.* 82 U.S.P.Q.2d at 1596 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”).

The Office Action makes the unsupported and conclusory statement that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of *Frieze* et al. with at least one cutting edges confined to the middle

⁵ See *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex*, Federal Register, Vol. 72, No. 195, p. 57527 (October 10, 2007) explain what is required when an obviousness rejection is made:

As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the difference between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel . . .

Office personnel fulfill the critical role of fact finder when resolving the *Graham* inquires. . . . Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. . . .

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C 103.

portion in view of *Desarzens et al.* to have an optimal cutting surface that further has a low profile.” Office Action at p. 4.

Yet, Applicants have shown above that neither *Frieze* nor *Desarzens* teaches or suggests a device according to the amended claims that has raised edges confined to a first portion in a band straddling a middle portion of the reamer, and that has a second portion that forms a portion of a surface free of any raised edges or openings. Beyond that, Applicants have also shown that any purported combination of such reamers is insufficient to arrive at the claimed reamers and would instead teach away from them.

In view of the foregoing, purported combination of *Frieze* and *Desarzens* suggested in the August 21, 2008 Office Action, as applied to amended claims 10, 12, 31, and 34, fails to meet the standards referred to above for establishing obviousness of these claims. Should the Office still opine, after reviewing the present response and these standards, that one or more of claims 10, 12, 31 and 34 are obvious, a full and clear statement of the grounds on which these claims are rejected pursuant to MPEP § 707.07(d) is requested so that any rejection is clearly articulated to provide the Applicants with the opportunity to provide evidence of patentability or otherwise reply completely at the earliest opportunity.⁶

For at least these reasons, the undersigned submits that the Office Action fails to establish *prima facie* obviousness relative to the amended claims. Withdrawal of the rejection and allowance of claims 10, 12, 31, and 34 is respectfully requested.

⁶ See 35 U.S.C. § 132; MPEP § 706.

B. *Rejection of Claims 26, 28, 30, 33 and 36*

The Office Action rejects claims 26, 28, 30, 33 and 36 under 35 U.S.C. § 103(a) as being unpatentable over *Frieze* in view of U.S. Patent No. 4,712,951 to *Brown* ("Brown"). The undersigned respectfully traverses this rejection and requests that it be withdrawn, for the reasons stated below.

Dependent claim 26, 28, 30, and 33 depend from independent claims 25, 27, 29 and 32 respectively. Claim 36 is independent. Claims 25 and 27 have been amended to require that the claimed reamer include:

- (a) An exterior surface with a second portion that is generally planar and free of any raised edges for cutting bone or cartilage or the combination thereof;
- (b) Wherein an intersection of the first portion of the exterior surface of the reamer (the portion that includes raised edges and openings) and the second portion of the exterior surface of the reamer forms an arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion.

Independent claims 29, 32, and 36 have been amended to require that the reamer include:

- (a) An exterior surface having a first portion and a second portion;
- (b) Raised edges confined to an area of the first portion in a band straddling a middle portion of the exterior surface; and
- (c) The second portion forms a portion of the exterior surface and has no raised edges or openings.

Dependent claims 26, 28, 30 and 33, and independent claim 36, additionally require that the second portion is substantially enclosed.

The Office Action fails to make and articulate findings of fact that support an obviousness rejection of claims 26, 28, 30, 33 and 36, as amended, under 35 U.S.C. § 103. As shown above, to establish *prima facie* obviousness of these claims under 35 U.S.C. § 103, the Office Action must (1) rely on references that expressly or inherently show each claimed element, and (2) show, either from the references themselves or in the knowledge generally available to one of ordinary skill in the art, that it would have been obvious under *Graham v. John Deere Co.*⁷ to modify the references or to combine teachings in the references to arrive at the claimed invention.⁸ Such a showing requires, among other things, evidence of an apparent reason to combine elements in references.⁹ The undersigned submits that: (a) even assuming the cited references could be combined, the combination of cited references fails to disclose or suggest each claimed element; (b) the purported combination of references is inapposite; and (c) the Office Action fails to articulate the required findings to establish *prima facie* obviousness.

1. *The Cited References Fail to Disclose or Suggest Each Claimed Element*

As discussed above, to establish *prima facie* obviousness of a claimed invention under 35. U.S.C. § 103, the Office Action must show, among other things, that the cited

⁷ 383 U.S. 1 (1966).

⁸ See MPEP §§ 2141 and 2143; *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d at 1395-96.

⁹ See *KSR Int'l Co. v. Teleflex, Inc.* 82 U.S.P.Q.2d at 1596 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)).

references disclose or inherently suggest each claimed element.¹⁰ *Frieze* and *Brown*, even if they could or should be combined, whether alone or in combination, fail to disclose or suggest each element of the amended claims. For at least that reason, the undersigned respectfully requests withdrawal of the rejection of pending claims 26, 28, 30, 33 and 36.

Regarding claims 26 and 28 after amendment, as established in Section II.B above, *Frieze* fails to disclose at least:

(a) A reamer having a first portion and at least one second portion, where the first portion has a peripheral edge that forms at least a portion of a first arc and where an intersection of the first portion and the at least one second portion forms a second arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion. *Frieze* does not disclose a first portion and at least one second portion where an intersection of the first portion and the at least one second portion forms an arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portion.

(b) A second portion that forms a generally planar exterior surface. As shown above, the open spaces identified by the Office Action as a second portion do not form a generally planar exterior surface portion.

Brown fails to disclose an intersection of a first portion and a second portion that forms an arc that extends continuously from one point on the peripheral edge of the first

¹⁰ See MPEP §§ 2141 and 2143; *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d at 1395-96.

portion to another point on the peripheral edge of the first portion. *Brown* also fails to disclose at least one second portion that forms at least one generally planar exterior surface.

Accordingly, neither *Frieze* or *Brown* discloses either (1) the claimed intersection of a first portion and a second portion that forms an arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portions, or (2) the claimed second portion that forms at least one generally planar exterior surface. Such omissions constitute an independent ground for reconsideration and withdrawal of the rejection of claims 26 and 28.

Regarding claims 30, 33 and 36 after amendment, as established in Section II.B above, *Frieze* fails to disclose at least:

(a) A reamer having a first portion and at least one second portion, where the raised edges are confined to the first portion in a band straddling a middle portion of the reamer. Instead, *Frieze* discloses a reamer having raised edges that are distributed throughout the entire surface of the reamer, and are not confined to a band straddling the middle portion.

(b) A second portion that forms a portion of the exterior surface. As shown above, the open spaces identified by the Office Action as a second portion do not form a portion of the exterior surface.

Brown fails to disclose a reamer having raised edges that are confined to a band straddling a middle portion.

Accordingly, neither *Frieze* or *Brown* discloses the claimed reamer having raised edges that are confined to a first portion in a band straddling a middle portion of the reamer.

Such an omission constitutes an independent ground for reconsideration and withdrawal of the rejection of claims 30, 33 and 36.

2. *The Combination of References is Inapposite*

Even if the references disclosed every claimed element, which they fail to do, and even if the Office Action cited any evidence to support a reason to combine these references, which it fails to do, such an effort to combine these references in the way suggested by the Office Action to arrive at the claimed invention is inapposite because it would render a result that (a) is insufficient to arrive at the claimed structures and (b) teaches away from the claimed structures rather than leading to them.

Even if a person of ordinary skill in the art tried to combine *Frieze* and *Brown*, which Applicants do not concede makes any sense, the combination would result in, most likely, a reamer having the crossing cutting blades of *Frieze* on its exterior with a notch cut in its underside. Such a combination does not produce a reamer having at least one second portion that forms at least one generally planar exterior surface, and having an intersection of a first portion and a second portion that forms an arc that extends continuously from one point on the peripheral edge of the first portion to another point on the peripheral edge of the first portions, as required by claims 26 and 28. Nor does it produce a reamer having raised edges confined to the first portion in a band straddling the middle portion of the reamer and having a second portion that is free of any raised edges or openings, as required by claims 30, 33 and 36.

Additionally, for similar reasons, combination of *Frieze* and *Brown* teaches away from the claimed structures. *Frieze's* raised edges with cutting teeth are distributed generally

around the entire exterior surface of the reamer, while *Brown's* shape is a reamer with a notch cut in its underside. The combination of *Frieze* and *Brown* teaches away from a reamer having a second portion that forms at least one generally planar exterior surface, and also teaches away from a reamer having raised edges confined to the first portion in a band straddling the middle portion of the reamer and having a second portion that is free of any raised edges or openings.

The undersigned accordingly respectfully requests that the obviousness rejection of pending claims 26, 28, 30, 33 and 36 be withdrawn for this independent reason.

3. *Failure to Articulate the Required Factual Findings for Prima Facie Obviousness*

As explained above, MPEP § 2142 provides that the “key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”¹¹ *See also*, 35 U.S.C. § 132; *KSR Int'l Co. v. Teleflex, Inc.* 82 U.S.P.Q.2d at 1596 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must

¹¹ See *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex*, Federal Register, Vol. 72, No. 195, p. 57527 (October 10, 2007) explain what is required where an obviousness rejection is made:

As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the difference between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel...

Office personnel fulfill the critical role of fact finder when resolving the *Graham* inquires. . . . Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. . . .

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C 103.

be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."); MPEP § 706.

The Office Action makes the unsupported and conclusory statement that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of *Frieze* et al. having at least substantially enclosed sides as part of the dome in view of *Brown* to have a smaller cutting surface and improved insertion capabilities to reduce patient trauma.” Office Action at p. 4.

Yet, Applicants have shown above that neither *Frieze* nor *Brown* teaches or suggests a reamer according to the amended claims that has (among other things) a second portion that forms at least one generally planar exterior surface (claims 26 and 28), or a reamer having raised edges confined to the first portion in a band straddling the middle portion of the reamer and having a second portion that is free of any raised edges or openings (claims 30, 33 and 36). Beyond that, Applicants have also shown that any purported combination of such reamers to arrive at the claimed invention is insufficient to arrive at the claimed reamers and would instead teach away from the invention.

In view of the foregoing, purported combination of *Frieze* and *Brown* suggested in the August 21, 2008 Office Action as applied to the amended claims fails to meet the standards referred to above for establishing obviousness of claims 26, 28, 30, 33 and 36. Should the Office still opine, after reviewing the present response and these standards, that one or more of claims 26, 28, 30, 33 and 36 are obvious, a full and clear statement of the grounds on which these claims are rejected pursuant to MPEP § 707.07(d) is requested so that any

rejection is clearly articulated to provide the Applicants with the opportunity to provide evidence of patentability or otherwise reply completely at the earliest opportunity.¹²

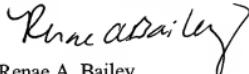
For at least these reasons, the undersigned submits that the Office Action fails to establish *prima facie* obviousness of the amended claims. Withdrawal of the rejection and allowance of claims 26, 28, 30, 33 and 36 is respectfully requested.

¹² See 35 U.S.C. § 132; MPEP § 706.

CONCLUSION

The undersigned respectfully submits that all pending claims are in a condition for allowance. Any fees due at this time maybe charged to Deposit Account Number 11-0855. If there are any matters that can be addressed by telephone, the Examiner is urged to contact the undersigned attorney at 404.532.6947.

Respectfully submitted,



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